

REMARKS

Status of the Claims

Claims 21, 22, 24, 25 and 27-32 are currently pending in the application. Claims 24, 25, 28 and 29 stand rejected. Claims 21, 22 and 27 are withdrawn as being drawn to a non-elected invention. The Examiner objects to claims 30-32. No amendments or cancellations are made to the claims. Reconsideration is respectfully requested.

Objections to the Claims

The Examiner objects to claims 30-32. (*See*, Office Action of May 22, 2008, at page 6, hereinafter, "Office Action"). The Examiner states that dependent claims 30-32 are objected to for depending from rejected base claims, but are otherwise allowable. However, Applicants believe that their response, below, to the remaining obviousness rejection of claims 24, 25, 28 and 29 sufficiently traverses all outstanding rejections precluding allowance of the presently pending claims.

Rejections Under 35 U.S.C. § 103(a)

Claims 24, 25, 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Abstract 3P-214 of Asano et al., 75th Annual Congress of the Japanese Biochemical Society, 74(8), 2002 (hereinafter, "Asano et al.") in view of Adair et al., *Human Antibodies Hybridomas*, 5:41-47, 1994 (hereinafter, "Adair et al."), and in view of Gill et al., *J. Biol. Chem.*, 259(12):7755-7760, 1984 (hereinafter, "Gill et al."), and further in view of Wu et al., *J. Mol.*

Biol., 294:151-162, 1999 (hereinafter, "Wu et al."). (*See, Id.*, at pages 4-6). Applicants traverse the rejection as hereinafter set forth.

The Examiner states that the "inventorship appears to be different from that of the instant invention, because for Abstract 3P-214 there are 5 authors, whereas the instant application names 4 inventors. Therefore, abstract 3P-214 appears to be 'by another.'" (*Id.* at page 4). Applicants note that the Examiner cites Asano et al. as being available as prior art under 35 U.S.C. § 102(a). (*See*, Office Action of July 27, 2007, at page 3).

Although Applicants do not agree that the presently claimed invention is obvious in light of the combined disclosures of the cited references, to expedite prosecution, Applicants submit herewith a Declaration under 35 U.S.C. § 1.132, signed by all of the present Inventors, which attests to the fact that while Hiroki Hayashi is a co-author of Asano et al., Hiroki Hayashi is not an Inventor of the subject matter described therein since he was working under the direction and supervision of the present inventors. (*See, In re Katz*, 215 U.S.P.Q. 14, CCPA 1982). Thus, Applicants believe that Asano et al. is removed as prior art.

The Examiner's putative support for the *prima facie* case of obviousness relies primarily on the disclosure of Asano et al. The Examiner states that Asano et al. disclose an Ex3 bispecific diabody which is made from the anti-EGFR 528 heavy chain and light chain with the OKT3 heavy chain and light chain. (*See*, Office Action, at page 5). The Examiner further states that Asano et al. do not disclose or suggest a humanized version of the Ex3 diabody. The Examiner then relies on the other secondary disclosures for support of these missing limitations. (*Id.* at pages 5-6). Thus, the present rejection is not supportable without the disclosure of Asano et al. Removal of Asano et al. as prior art is therefore believed to address this remaining rejection.

Reconsideration and withdrawal of the obviousness rejection of claims 24, 25, 28 and 29 are respectfully requested.

Rejoinder

Having removed the last remaining rejection of claims 24, 25, 28 and 29, Applicants respectfully request rejoinder and allowance of withdrawn method claims 21, 22 and 27, pursuant to M.P.E.P. § 821.04. That is, where Applicants elect claims directed to the product, and a product is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claims will be rejoined in accordance with the provisions of M.P.E.P. § 821.04. Such process claims that depend from or otherwise include all the limitations of the patentable product are entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Thus, in the event of rejoinder, Applicants respectfully request that the requirement for restriction between the product claims and the rejoined process claims be withdrawn, and the rejoined process claims be fully examined for patentability according to the provisions of 37 C.F.R. § 1.104.

Therefore, rejoinder and allowance of withdrawn claims 21, 22 and 27 are respectfully requested.

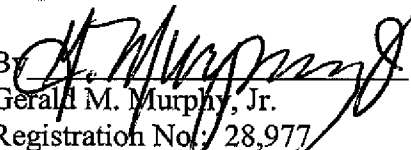
CONCLUSION

If the Examiner has any questions or comments, please contact Thomas J. Siepmann, Ph.D., Registration No 57,374, at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: September 22, 2008

Respectfully submitted,

By 
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Attachments: Declaration under 37 C.F.R. § 1.132